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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,138	12/13/2000	Joane Goodroe	GOOD1 (11652.107070)	8196

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EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,138

Applicant(s)

GOODROE ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 13 September 2000. Claims 1-23 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 21 recites the limitation "said web page" in line 6; and

(B) Claim 22 recites the limitation "the web site" in line 3.

There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

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5. Claims 1-20, 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-20, 23 only recite abstract ideas. The recited claims detailing the steps of collecting data, establishing a benchmark and standardizing a clinical procedure do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute different parts of a method for increasing resource utilization efficiency.

In this regard it should be noted that the Examiner has interpreted "a hypermedia document," as recited in claim 23, which is not tangibly embodied on any media or on a computer as not falling within the technological arts.

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Furthermore, should the hypermedia document of claim 23 be amended to be tangibly embodied on a computer-readable medium, as regards the further recitation in claim 23 of "hyperlinks providing access to a plurality of files stored on a web site," merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a standardized clinical procedure (i.e., repeatable) that can be used in allocating and utilizing resources (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-20, 23 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-7, 9-18, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCartney, U.S. Patent Number 5, 778, 345 in view of Dang, U.S. Patent Number 5, 835, 897.

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(A) As per claim 1, McCartney teaches a method for increasing resource utilization efficiency and identifying areas to enhance quality, said method comprising the steps of:

collecting data for a clinical procedure performed at the point of patient care

(McCartney; see at least column 9, lines 15-38); and

establishing a benchmark based upon at least a portion of said data (McCartney; see at least column 12, lines 30-35, column 18, lines 17-49, column 21, lines 45-56).

McCartney fails to explicitly disclose standardizing said clinical procedure based upon said benchmark.

However, the above features are well-known in the art, as evidenced by Dang.

In particular, Dang teaches creating or engineering quality improvement protocols (reads on standardizing) said clinical procedure based upon said benchmark (Dang; column 19, lines 40-64, column 36, lines 15-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of McCartney to include creating or engineering quality improvement protocols (reads on standardizing) said clinical procedure based upon said benchmark, as taught by Dang, with the motivations of providing an objective means for measuring and quantifying health, care services (Dang; see at least Abstract).

(B) As per claims 3-7, McCartney and Dang teach a method as analyzed and discussed in claim 1 above

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wherein said collecting step comprises determining resources used in said clinical procedure (McCartney; column 2, lines 56-58, column 3, lines 50-66, column 5, line 45 to column 6, line 39, column 9, lines 15-38);

wherein said establishing step comprises identifying resources to be used to establish said benchmark for said clinical procedure (McCartney; column 2, lines 56-58, column 3, lines 50-66, column 5, line 45 to column 6, line 39, column 12, lines 30-35, column 18, lines 17-49, column 21, lines 45-56);

wherein standardizing step comprises setting the quantity of at least one resource to be used for said clinical procedure while correlating the clinical outcome (Dang; column 7, lines 32-35, column 19, lines 40-64, column 36, lines 15-19);

further comprising the steps of accepting a request for said clinical procedure, and requesting resources to be utilized in said clinical procedure based upon said benchmark (Dang; column 4, lines 46-56, column 19, lines 40-64, column 36, lines 15-19); and

further comprising the steps of accepting a request for said clinical procedure, and allocating resources to said clinical procedure based upon said benchmark (McCartney; see at least Abstract, column 2, lines 56-58, column 3, lines 50-66, column 5, line 45 to column 6, line 39, column 12, lines 30-65, column 18, lines 17-49, column 21, lines 45-56).

(C) As per claims 9-15, McCartney, and Dang teach a method as analyzed and discussed in claims 1 and 7 above

further comprising the step of scheduling the requisitioning or restocking of supplies based upon said benchmark (Jones; Figure 8, Item 712, column 1, lines 61-64, column 3, line 63

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to column 4, line 5, column 6, lines 13-21, column 10, lines 11-19, column 14, lines 5-20, column 17, lines 1-11);

further comprising the step of automatically ordering supplies from vendors based upon the needs of the clinical practice based upon said benchmark (Jones; column 3, line 54 to column 4, line 5, column 10, lines 10-19);

further comprising the step of compiling a report of resources utilization based upon said data (McCartney; see at least Figure 14, Item 670, Figure 16, Item 899, column 5, line 45 to column 6, line 39, column 9, lines 16-39, column 12, lines 6-16, column 16, lines 29-43, column 19, line 60 to column 20, line 7, column 21, line 45 to column 22, line 2);

wherein said report comprises a clinical outcomes report (McCartney; see at least Figure 14, Item 670, Figure 16, Item 899, column 5, line 45 to column 6, line 39, column 9, lines 16-39, column 12, lines 6-16, column 16, lines 29-43, column 19, line 60 to column 20, line 7, column 21, line 45 to column 22, line 2);

wherein said report comprises a procedure results report (McCartney; see at least Figure 14, Item 670, Figure 16, Item 899, column 5, line 45 to column 6, line 39, column 9, lines 16-39, column 12, lines 6-16, column 16, lines 29-43, column 19, line 60 to column 20, line 7, column 21, line 45 to column 22, line 2);

wherein said report comprises a patient profile report (Dang; column 5, lines 20-34, column 19, lines 18-23, column 6, lines 49-64); and

wherein said report comprises information on medication used during said clinical procedure (Dang; Figure 8C, column 6, lines 49-64, column 7, lines 23-30).

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(D) As per claims 16-18, 20, McCartney, and Dang teach a method as analyzed and discussed in claims 1 and 11 above

wherein said report comprises information on the length of stay of patients undergoing said clinical procedures (McCartney; column 12, lines 30-35);

wherein said report comprises information on the demographics of patients undergoing said clinical procedure (McCartney; see at least Figure 8, column 5, line 45 to column 6, line 39, column 10, lines 51-65. column 11, lines 45-67, column 12, lines 56-56, column 14, lines 60-67);

wherein said collecting step comprises monitoring the cost of said clinical procedure to provide a benchmark (McCartney; column 5, line 45 to column 6, line 39, column 12, lines 6-36, column 17, lines 60-62); and

wherein said collecting step comprises storing said data collected from performing said clinical procedures (McCartney; see at least column 9, lines 15-38).

(E) Claim 21 differs from method claim 1 by reciting a "computer-readable medium on which is stored a computer program..." in the preamble and "entering said data on said web page" on line 6. As per these limitations, Dang clearly discloses his invention to be implemented on a computer-readable medium on which is stored a computer program and "residing on any number of computer system architectures, for example a wide area network (WAN) ...[such as the Internet]..." Dang also teaches medical claim data is input and processed by loading the computer program into the computer system memory (reads on "entering said data on said web page") (Dang; column 6, line 41 to column 7, line 17). The remainder of claim 21 repeats the limitations of claim 1, and is therefore rejected for the same reasons given above for claim 1.

The motivations for combining the respective teachings of McCartney, and Dang are as given in the rejection of claim 1 above, and incorporated herein.

(F) Claim 22 differs from method claim 1 by reciting "enabling a user..." and "using a computer and a telecommunications link between the computer and the web site" in the preamble and "providing a web page to the computer" on line 5 and "entering said data on said web page" on line 7. As per these limitations, Dang clearly discloses his invention to be "residing on any number of computer system architectures...[...] a client-server system ...[...] ..., for example a wide area network (WAN) ...[such as the Internet]... " (reads on "using a computer and a telecommunications link between the computer and the web site" and "providing a web page to the computer") (Dang; column 6, lines 41-47). Dang also teaches medical claim data is input and processed by loading the computer program into the computer system memory (reads on "entering said data on said web page") (Dang; column 6, line 41 to column 7, line 17). The remainder of claim 21 repeats the limitations of claim 1, and is therefore rejected for the same reasons given above for claim 1.

The motivations for combining the respective teachings of McCartney, and Dang are as given in the rejection of claim 1 above, and incorporated herein.

(G) Claim 23 differs from method claim 1 by reciting "a hypermedia document for measuring operational efficiency and effectiveness of a clinical practice" in the preamble and "said hypermedia document comprising: a plurality of hyperlinks providing access to a plurality of files stored on a web site " on lines 3-5. As per these limitations, Dang clearly discloses his

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invention to be "residing on any number of computer system architectures...[...] a client-server system ...[...] ..., for example a wide area network (WAN) ...[such as the Internet]... " (reads on comprising "a hypermedia document" and " said hypermedia document comprising: a plurality of hyperlinks providing access to a plurality of files stored on a web site") (Dang; column 6, line 41 to column 7, line 17). The remainder of claim 23 repeats the limitations of claim 1, and is therefore rejected for the same reasons given above for claim 1.

The motivations for combining the respective teachings of McCartney, and Dang are as given in the rejection of claim 1 above, and incorporated herein.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCartney, U.S. Patent Number 5, 778, 345 in view of Dang, U.S. Patent Number 5, 835, 897 as applied to claim 1 above, and further in view of article, "Cost Control Incented Many Ways Despite OIG Ruling on Gainsharing, "April 12, 2000, Physician Compensation Report, URL: <http://www.findarticles.com/p/articles/mi_m0FBW/is_4_1/ai_61933228/print>, hereinafter known as CostControl.

(A) As per claim 2, McCartney and Dang teach a method as analyzed and discussed in claim 1 above.

McCartney and Dang fail to explicitly disclose a method further comprising the step of rewarding physicians' efforts to reduce costs by providing a share of savings in response to utilizing said standardized procedure.

However, the above features are well-known in the art, as evidenced by CostControl.

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In particular, CostControl teaches rewarding physicians' efforts to reduce costs by providing a share of savings in response to utilizing said standardized procedure (CostControl; paragraphs 1-2, 5, 8-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of McCartney to include rewarding physicians' efforts to reduce costs by providing a share of savings in response to utilizing said standardized procedure, as taught by CostControl, with the motivations of producing cost cutting incentives, such as those aimed at expenses each physician can control, and holding down costs under different formulas: some directed at group savings and others at individual savings; some aimed at specific costs and others at overall costs; some tied to quality and some not (CostControl; see at least paragraphs 1-2).

9. Claims 8, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCartney, U.S. Patent Number 5, 778, 345 in view of Dang, U.S. Patent Number 5, 835, 897 as applied to claims 1 and 7 above, and further in view of Jones et al., U.S. Patent Number 6, 117, 073.

(A) As per claim 8, McCartney and Dang teach a method as analyzed and discussed in claims 1 and 7 above.

McCartney and Dang fail to explicitly disclose a method further comprising the step of verifying the existence of supplies in inventory.

However, the above features are well-known in the art, as evidenced by Jones.

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In particular, Jones teaches verifying or tracking the existence of supplies in inventory (Jones; Figure 5b, Item 372, Figure 10, Item 920, column 3, lines 54-61, column 5, lines 6-20, column 10, lines 11-19, column 14, lines 5-20, column 17, lines 1-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of McCartney to include the step of verifying or tracking the existence of supplies in inventory, as taught by Jones, with the motivations of providing a comprehensive medical system that includes managing a clinical diagnosis and treatment and accurately billing the patient for the services rendered, as well as ensuring adequate supplies and equipment (Jones; see at least column 1, lines 30-32, column 1, line 65 to column 2, line 3, column 10, lines 11-18).

(B) As per claim 19, McCartney, Dang and Jones teach a method as analyzed and discussed in claim 1 above

wherein said collecting step comprises monitoring costs of requisitioned supplies (Jones; Figure 10, Item 920, column 2, lines 6-24, column 3, lines 54-61, column 5, lines 6-20, column 10, lines 11-19).

Conclusion

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Nickerson et al., U.S. Patent Number 6, 785, 717, Torma et al., U.S. Patent Number 5, 365, 425, Quernemoen, U.S. Patent Number 6, 453, 268, Kessler et al., U.S. Patent Number 5, 324, 077, Lockwood, U.S. Patent Number 5, 706, 441,

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and the article teach the environment of clinical operational management and economic incentives.

The Urgent Need to Improve Health Care Quality. Sept. 16,1998. JAMA Vol. 280, No.

11. [Retrieved on November 9, 2004]. Retrieved from Internet. URL: <<http://jama.ama-assn.org/cgi/content/full/280/11/1000>>.

10. Any response to this action should be mailed to:

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(Receptionist).

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NP

Natalie A. Pass

November 12, 2004



ALEXANDER KALINOWSKI
PRIMARY EXAMINER